

REMARKS

I. Introduction

Claims 1 and 5-13 remain pending in the present application. Claims 1 and 5-10 have been amended, and new claim 13 has been added. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1, 5 and 7-12

Claims 1, 5 and 7-12 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by United States Patent No. 6,302,190 (“Clamp”). For at least the following reasons, Applicants respectfully submit that pending claims 1, 5 and 7-12 are patentable over Clamp.

To anticipate a claim under §102(b), each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 105 3 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Amended claim 1 recites, in relevant parts, “a cooling device for enabling heat to be dissipated from the housing via a liquid flowing therethrough, wherein the cooling device is integrally formed in the bottom section, and wherein the bottom section is formed as a cooling plate, and wherein the cooling device includes at least one one-piece cooling tube integrally formed in the bottom section and extending substantially across the length of the bottom section, and wherein the bottom section including the one-piece cooling tube is formed in a single casting operation.” Applicants note that the change from “one-piece cooling duct” to “one-piece cooling tube” was made in order to highlight the fact that the cooling device of the present invention is a fully enclosed conduit formed of a single piece, as clearly shown in Figs. 1-3 and

fully described in the original Specification, e.g., p. 2, l. 28 – p. 3, l. 6, and p. 3, l. 18-21. In contrast to the present claimed invention, Clamp clearly does not teach or suggest “one-piece cooling tube integrally formed in the bottom section and extending substantially across the length of the bottom section, and wherein the bottom section including the one-piece cooling tube is formed in a single casting operation.” In this regard, the cooling duct 40 shown in Fig. 2 of Clamp clearly is not a “one-piece cooling tube integrally formed in the bottom section . . . wherein the bottom section including the one-piece cooling tube is formed in a single casting operation”; instead, enclosing the cooling duct 40 requires a separate piece 34. Furthermore, element 46 shown in Fig. 2 of Clamp clearly does not extend “substantially across the length of the bottom section.” Because the “the bottom section including the one-piece cooling tube is formed in a single casting operation,” the present claimed invention eliminates the disadvantage of having to provide a separate cover and associated sealing of the cover to the cooling duct.

For at least the foregoing reasons, Applicants submit that claim 1 and its dependent claims 5 and 7-12 are not anticipated by Clamp. In addition, since newly introduced method claim 13 recites features substantially corresponding to the features recited in claim 1, Applicants submit that newly introduced claim 13 is in allowable condition.

III. Rejection of Claim 6

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,302,190 (“Clamp”) in view of U.S. Patent 4,652,970 (“Watari”). For the following reasons, Applicants respectfully submit that claim 6 is patentable over the combination of Clamp and Watari.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986).

Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 6 depends on claim 1. As noted above, Clamp clearly does not anticipate parent claim 1. In addition, Watari clearly does not remedy the deficiencies of Clamp as applied against parent claim 1. Accordingly, even if one assumed for the sake of argument that some motivation existed for combining the teachings of Clamp and Watari, with which assumption Applicants do not agree, the overall teachings of Clamp and Watari would not render obvious claim 1 and its dependent claim 6. Therefore, the obviousness rejection of claim 6 should be withdrawn.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that all pending claims 1 and 5-13 of the present application are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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